

21. A system according to claim 19, and further including a projection lens for reducing and projecting a slit image of the mask onto said film.

22. A semiconductor thin film forming system for modifying a predetermined region of a semiconductor thin film by exposing the semiconductor thin film to a projected light patterned through plural patterns formed on a photo mask,

wherein said light is applied in such a manner that the intensity of said light in a predetermined area on the photo mask is distributed within a range of  $\pm$  11.2% of an average intensity of said light in said area...

**REMARKS**

New claims 17-22 have been added to further scope the invention, and find support at page 91, line 10 (original specification) to page 93, line 16.

Before considering the 112 rejections substantively, Applicants note this is the second Action on the merits, before the same Examiner. Original claim 1 specifically recited the range now called into question in this latest Action. In fact, in the previous Action, the Examiner specifically discussed the range now called into question (see cipher 3 of the previous Action). Since the range previously must have been considered to be enabled, Applicants do not understand why the range now has become non-enabled. Nothing has changed vis-à-vis this limitation of claim 1. While Applicants appreciate a thorough examination, the Examiner has not provided a legitimate basis for now questioning enablement vis-à-vis the claimed range.

It is well settled that the Examiner bears the initial burden of providing reasons why a supporting disclosure does not enable a claim. *In re Marzocchi*, 439 F.2d 220, 223, 169 U.S.P.Q. 367, 369 (CCPA 1971). In rejecting the claims as not being enabled, the Examiner makes reference to page 11 of the specification and Figure 11 as providing the only support in

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the specification. The Examiner is in error. The Examiner's attention is directed, e.g., to homogenizer 3241 in FIGS. 45 and 46 and on pages 73-80, and to page 91, line 10 through page 93, line 16 (original specification). An exemplary mechanism for uniformizing the light is disclosed. Applicants contend that this disclosure coupled with page 11 and Figure 11 is sufficient to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention.

Moreover, it is well settled that the specification need not disclose what is well-known in the art. See, for example, *Hybritech Inc. v. Monoclonal Antibodies, Inc.*, 802 F.2d 1367, 1385, 231 U.S.P.Q. 81, 94 (Fed. Cir. 1986). It is submitted the Examiner has not provided any evidence that those skilled in the art would be unable to practice the claimed invention. Indeed, unlike *Hybritech*, in which unpredictable biological systems were involved, the present claimed invention involves a highly reproducible, physical, i.e., optical system. Accordingly, it is submitted the Examiner's rejection of claim 1 under 35 USC § 112, first paragraph, as not being enabled is in error.

The Examiner further rejects claim 1 under 35 USC § 112, first paragraph, stating that there was no disclosure in the originally filed specification that the "peak intensity of the light projected and applied on the semiconductor thin film is uniformized to an identical extent with the peak intensity of the intensity distribution on the photo mask." The Examiner is in error. The Examiner's attention is directed, e.g., to page 12, lines 4-6 and to the second full paragraph on page 14 of the original specification. This paragraph clearly describes the claimed subject matter in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the Application was filed, had possession of the claimed invention.

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Turning to the art rejections in the previous Action, the Examiner acknowledged that the primary reference Suzuki nowhere teaches the average intensity varying ( $\pm$ ) 11.2% as required by Applicants' claim 1. Even assuming *arguendo* one skilled in the art would be motivated to combine the Suzuki reference with Guenther et al., Guenther et al. also fails to teach this. Thus, such combination still would not achieve Applicants' claimed invention including a range of  $\pm$  11.2% of average intensity, or a spatial distribution of peak intensity of light projected and applied on a semiconductor thin film is uniformized to an identical extent with the peak intensity of the intensity distribution on the photo mask as required by claim 1. Accordingly, claim 1 and the several newly added dependent claims, cannot be said to be obvious from Suzuki in view of Guenther et al.

Having dealt with all the objections raised by the Examiner, it is believed the Application now is in order for allowance.

In the event there are any fee deficiencies or additional fees are payable, please charge them (or credit any overpayment) to our Deposit Account Number 08-1391.

Respectfully submitted,



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**CERTIFICATE OF MAILING**

I hereby certify that this correspondence is being deposited with the United States Postal Service as First Class Mail in an envelope addressed to: Assistant Commissioner of Patents, Washington, D.C. 20231 on September 4, 2002, at Manchester, New Hampshire.

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